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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/522,094 | 01/24/2005 | Enrico Gerardus Albertus Linders | 70059USPCT | 9236 |
| 22847 7590 02/04/2011 SYNGENTA BIOTECHNOLOGY, INC. PATENT DEPARTMENT 3054 CORNWALLIS ROAD P.O. BOX 12257 RESEARCH TRIANGLE PARK, NC 27709-2257 | | | EXAMINER ROBINSON, KEITH O NEAL | |
| | | | ART UNIT 1638 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IP.SBI@syngenta.com

Office Action Summary

Application No.

10/522,094

Applicant(s)

LINDERS ET AL.

Examiner

KEITH O. ROBINSON

Art Unit

1638

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 93-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 93-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/10/2010
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's cancellation of claims 1-92 and addition of new claims 93-103, filed September 15, 2010, have been received and entered in full.

An office action was mailed July 16, 2009 in response to claims filed May 4, 2009. Applicant responded to the office action October 5, 2009 canceling claims 55-70 and adding new claims 75-81 (claims 71-81 were under examination). Applicant filed claims March 29, 2010 canceling claims 1-81 and adding new claims 82-92; however, the canceled claims were drawn to the elected invention and the new claims were drawn to a non-elected invention, thus, Applicant's response was considered non-responsive (see 'Notice of non-compliance' filed June 11, 2010). In Applicant's response, filed June 18, 2010, claims 71-81 were submitted and Applicant responded to the '1.105 Request' that was mailed December 30, 2009. The claims filed June 18, 2010 were numbered incorrectly because claim 71-81 were canceled in the claim amendments filed March 29, 2010; thus, a 'Notice of non-compliance' was mailed September 10, 2010. Applicant filed claim amendments September 15, 2010 canceling claims 1-92 and adding new claims 93-103.

Claims 93-103 are under examination.

Response to Arguments

It is noted that Applicant has not responded to the rejection set forth in the office action mailed July 16, 2009 with regard to the 35 USC § 103 rejection on pages 8-12 of the office action mailed July 16, 2010; thus, the rejection has been maintained, as cited

below. Applicant's response filed October 5, 2009 has overcome the 35 USC § 112, first paragraph for enablement on pages 6-8 of the office action mailed July 16, 2009 and the claim amendments filed September 15, 2010 have overcome the 35 USC § 112, first paragraph for written description on pages 3-6 of the office action mailed July 16, 2009. However, new rejections have been included in the instant office action in response to the claim amendments filed September 15, 2010, as cited below.

Claim Objections

Claim 98 is objected to because of the following informalities: The claim recites "the melon plant of claim 93"; however, the plant of claim 93 is not a melon plant but rather a *B. oleracea* plant. The objection can be overcome by amending the claim to replace "melon" with "*B. oleracea*". Appropriate correction is required.

Claim Rejections - 35 USC § 112, first paragraph – Written Description

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 93-103 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In response to the '1.105 Request' mailed December 30, 2009, Applicant discloses that line CFL667 was produced by a cross of proprietary lines (wrh1)17-3-3 r16 BK942 (female) and (a1.k2.wsd4)1 (male) (see 'Remarks' filed June 18, 2010). Thus, line CFL667 reads on an F1 hybrid.

Claim 93 claims progeny of line CFL667 or a plant derived from line CFL667. Any progeny or plant derived from an F1 plant reads on F2 plants or further generations which constitutes a segregating generation wherein plants in such a generation would not possess all the genotypic and/or phenotypic characteristics of the claimed invention.

Thus, the claim encompasses progeny of any generation of line CFL667 including 4th, 12th, 20th and even 100th generation plants including all possible genetic variations not possessed by the deposited line.

Claims 100-102 read on seed, plants and parts thereof and fruit, respectively, produced by crossing two parent *B. oleracea* plants wherein at least one of said parent *B. oleracea* plants is the *B. oleracea* plant of claim 98, which has all of the morphological and physiological characteristics of the plant of claim 93.

As stated above, the plant of claim 93 reads on an F1 plants and even further generations; therefore, the crossing of an F1 or further generation plant with another plant would read on plants that would not possess the genotypic and/or phenotypic characteristics of the claimed invention.

A sufficient description of a genus requires the disclosure of either a representative number of species falling within the scope of the genus or structural features common to the members of the genus so that one of skill in the art can visualize or recognize the members of the genus. In the instant case, Applicant has not disclosed a representative number of species falling within the scope of the genus because it is unclear if the progeny plants disclosed in the specification have the claimed characteristics. In addition, the specification does not describe the structural features that distinguish line CFL667 subsequent generation progeny from other *B. oleracea* plants.

Therefore, given the lack of written description in the specification with regard to the structural features of the claimed progeny, it is not clear that Applicant was in possession of the claimed invention at the time this application was filed.

See *University of Rochester v. G.D. Searle & Co., Inc.*, 68 USPQ2d 1424,1433 (DC WNY 2003), which teaches that method claims are properly subjected to a written description rejection if the starting material required by that method is itself inadequately described; thus, claims 99 and 103 are rejected. In the instant case, both claims 99 and 103 require the *B. oleracea* plant of claim 98 which, as stated above, has been rejected for lack of written description. Therefore, claims 99 and 103 are not adequately described because the plant used in the method is not adequately described.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 93-103 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chiang et al (Euphytica 32: 479-483, 1983).

The claims read on a *B. oleracea* plant resistant to clubroot disease, wherein the resistance to clubroot is monogenic and dominant and wherein the plant is a plant of

line CFL667 or a progeny of said line comprising the monogenic and dominant resistance to clubroot comprised in said line, or a plant derived from said line comprising the monogenic and dominant resistance to clubroot comprised in said line. Therefore, the claims are not only drawn to the deposited line, but rather to further generations of plants of line CFL667.

Chiang et al teach a *B. oleracea* plant resistant to clubroot disease, wherein the resistance is monogenic and dominant. See, for example, page 482, 1st paragraph where it states, "the inheritance of resistance to...the clubroot pathogen is controlled by a single dominant gene...[and] the monogenic dominant inheritance found in this study indicates that this single gene is located on a chromosome in the 'a1' genome".

The Office does not have the facilities and resources to provide the factual evidence needed in order to establish that the product of the prior art does not possess the same, material, structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is on the Applicant to provide that the claimed product is different from those taught by the prior art and to establish patentable differences. See *In re Best*, 195 USPQ 430, 433 (CCPA 1997), which teaches that where the prior art product seems to be identical to the claimed product, except that the prior art is silent as to a particularly claimed characteristic or property, then the burden shifts to Applicant to provide evidence that the prior art would neither anticipate nor render obvious the claimed invention. In the instant case, the *B. oleracea* plant taught by Chiang et al seems to be identical to the claimed invention because both teach *B. oleracea* plants having resistance to clubroot that is monogenic and dominant.

Since "a progeny of line CFL667" and "a plant derived from line CFL667" read on further generations of plants that would not possess all of the genes of line CFL667, the cited plant would read on such plants.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

No claims are allowed.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEITH O. ROBINSON whose telephone number is (571)272-2918. The examiner can normally be reached Monday – Friday, 8:00 a.m. - 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached at (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Keith O. Robinson

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